

## REMARKS

In the Office Action, claims 1-80 were rejected under the judicially-created doctrine of obviousness-type double patenting as allegedly being unpatentable over Stirton (U.S. Patent No. 6,479,200 B1) in view of Lensing (U.S. Patent No. 6,383,824 B1). However, the Examiner indicated that claims 1-80 would be allowable if a timely terminal disclaimer were filed to overcome the double patenting rejection. Applicants respectfully traverse the Examiner's rejections. It is respectfully submitted that the inventions claimed in the present application are not obvious in view of the claimed inventions of either Lensing or Stirton.

The proper analysis in the context of a non-statutory double patenting rejection requires that comparison can be made only with respect to what is claimed in the earlier patent, not by looking to the claims in the earlier patent for anything that happens to be mentioned in the claim as though it were a prior art reference. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 23 U.S.P.Q.2d 1839, 1845-46 (Fed. Cir. 1992) (copy attached for the convenience of the Examiner). Thus, it is not proper to dissect the claim language of the issued patents as though the claims of the prior art patent were an item of prior art. Rather, the comparison should be between the inventions defined by the claims, not the language in the claims. Moreover, the claimed inventions must be considered as a whole in performing the double patenting analysis. *Id.* The Federal Circuit has held that obviousness-type double patenting rejections must include clear evidence to establish why an alleged variation of an invention claimed in a prior patent would have been obvious. *In re Kaplan*, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986) (copy attached for the convenience of the Examiner).

As an initial matter, it is respectfully submitted that there are some very fundamental differences between the claimed inventions of Lensing and Stirton and the claimed inventions of

the pending application. First, as an initial matter, the claims of the present application are generally directed to a method of stopping an etching process performed on a plurality of photoresist features of a grating structure based upon a comparison of a generated optical trace and a target optical trace. The claims of the Lensing patent are generally directed to methods of controlling or stopping a deposition process that is performed to form a process layer above a grating structure based upon a comparison of a generated profile trace to a target trace that corresponds to a process layer having a desired surface profile. The claimed inventions of Stirton are generally directed to modifying at least one parameter of a stepper exposure process to be performed on a subsequently processed substrate in an effort to achieve a desired profile of a plurality of photoresist features.

Based upon the above-stated legal standards, it is simply not understood how the Examiner arrived at the conclusion that the claims of the present application are obvious in view of the claims of the patents to Lensing and Stirton. When the claimed inventions are considered as a whole, it is respectfully submitted that the Examiner erred in reaching the obviousness conclusion. For example, even when the various claims are considered at a very high level, it is not understood how the claimed inventions of the present application (directed to an etching process performed on a plurality of photoresist features) is even remotely obvious in view of the claimed inventions in Lensing (directed to a method of controlling or stopping a deposition process that is performed to form a process layer) or the claimed inventions in Stirton (directed to methods of controlling a stepper exposure process to be performed on a subsequently processed substrate). This is even more true when each of the claimed inventions are considered as a whole, including all of the limitations set forth in each of the claims.

As stated in *General Foods*, it is improper to look at the claimed invention of the earlier patent for anything that happens to be mentioned as though it were a prior art reference. It is respectfully submitted that the Examiner did, improperly, do just that in making the obviousness-type double patenting rejection. This is clear from the first paragraph on page 4 of the Office Action wherein the Examiner stated "it would have been obvious ... to integrate the 6,479,200 Patent claim to [sic: into] the 6,383,824 Patent to form a grating structure in a layer of photoresist material in order to provide a more accurate pattern, which leads to a better quality and reliable product and device."

From the foregoing, it is respectfully submitted that the obviousness-type double patenting rejection is improper. A comparison of the claimed inventions leads to the inescapable conclusion that the claims of the present application are not obvious in view of the claims of the patents to Lensing or Stirton. Withdrawal of the obviousness-type double patenting rejection is respectfully requested. The Examiner is invited to contact the undersigned attorney at (713) 934-4055 with any questions, comments or suggestions relating to the referenced patent application.

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